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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/675,684

09/30/2003

Arthur Louis Gaetano JR.

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EXAMINER

WORJLOH, JALATEE

ART UNIT

PAPER NUMBER

3685

MAIL DATE

DELIVERY MODE

10/06/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/675,684	Applicant(s) GAETANO ET AL.	
	Examiner Jalatee Worjloh	Art Unit 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 10-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This Office Action is responsive to the amendment filed June 10, 2008.
2. Claims 1-35 are pending.
3. Claims 1-9 have been examined.

Response to Arguments

4. Applicant's arguments filed June 10, 2008 have been fully considered but they are not persuasive.
5. Applicants argue that Russell does not teach "a virtual warehouse containing intangible software components specifically selected to be compatible with a certain target hardware device". However, "to be" is a functional recitation that has been considered but are given little patentable weight because they fail to add any structural limitations and are thereby regarded as intended use language. A recitation of the intended use of the claimed product must result in a structural difference between the claimed product and the prior art in order to patentably distinguish the claimed product from the prior art. If the prior art structure is capable of performing the intended use, then it reads on the claimed limitation. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) ("The manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself."); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). See also MPEP §§ 2114 and 2115. Unless expressly noted otherwise by the Examiner, the claim interpretation principles in this paragraph apply to all examined claims currently pending.

6. Applicants argue that the virtual warehouse storage is not located on the target hardware device nor does Applicant's claim recite this. Notice, the Examiner cites paragraph [0031] of Russell, which describes a content server that stores content. So, the storage is not located on the target hardware as Applicants assert.

7. Applicants argue that the target device is not required to communicate directly with the virtual warehouse website, but rather a separate device does (i.e. the programming workstation). The Examiner notes that the claims do not clearly distinguish the programming workstation from the target hardware device. Also, it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art (see *In re Dulberg*, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961) and MPEP §2144.04 V.C).

8. In response to applicants argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the target hardware is separate from the programming) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-3, 7, and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Publication No. 2002/0049679 to Russell et al. ("Russell").

Referring to claim 1, Russell discloses a client site having a target hardware device (i.e. user-network enabled device), said hardware device having a unique identifier see paragraphs [0009] & [0049] – UND with hard drive serial number), a virtual warehouse website (i.e. protected database) comprising a personal inventory of intangible software specifically selected to be compatible with said target hardware device(see paragraphs [0011] & [0031]), a license generator generating a software site license comprising one or more of said components for said target hardware device, aid software site license being stored in said virtual warehouse storage for later use (see paragraphs [0047] &[0045]) and a programming workstation (i.e. media player) receiving said software site license from said virtual warehouse storage for said target device (see paragraphs [0012] &[0014]).

Referring to claim 2, Russell discloses the system wherein said programming workstation receives an electronic file transfer comprising said license (see paragraph [0026]).

Referring to claim 3, Russell discloses the system wherein said programming workstation stores a copy of said site license (see claim 28).

Referring to claim 7, Russell discloses the system wherein said license sales site receives a purchase order from said client site comprising said target hardware device in response to said order, said license sales site establishes said virtual warehouse for said client site and places said licensable components for said target hardware device in said virtual warehouse (see claim 1 above).

Referring to claim 9, Russell discloses a representative of said client site (i.e. user) and a purchase order prepared by said representative and received at said license sales site, said order comprising said target hardware device, said representative having said programming workstation and installing said license to said target sales device prior to delivering said target to said client site (see claim 1 above).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Russell as applied to claim 1 above, and further in view of U.S. Patent No. 7209902 to Stefik et al. (“Stefik”).

Russell discloses a virtual warehouse and performing integrity check (see claim 1 above and paragraph [0063]). Russell does not expressly disclose the system wherein said virtual warehouse comprises a multi-password protected website comprising entry of a password unique to said client site and an ID unique to said target hardware device or comprising a priority level of access to said virtual warehouse. Stefik discloses the system wherein said virtual warehouse comprises a multi-password protected website comprising entry of a password unique to said client site and an ID unique to said target hardware device or comprising a priority level of access to said virtual warehouse (see claims 1 and 22). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by

Russell to include a virtual warehouse comprises a multi-password protected website comprising entry of a password unique to said client site and an ID unique to said target hardware device and a priority level of access to said virtual warehouse. One of ordinary skill in the art would have been motivated to do this because it prevents unauthorized individuals from accessing the system.

13. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Russell as applied to claim 1 above.

Referring to claim 6, Russell discloses wherein said programming workstation displays said licensable components (see claim 1 above). Russell does not expressly teach displaying for confirmation from a user prior to said license generator generating said software site license. However, this is an intended use feature and the Examiner notes that the workstation of Russell is capable of performing the process. "A recitation directed to the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art, if the prior art has the capability to so perform" (see MPEP 2114 and Ex parte Masham,"2 USPQ2d 1647 (1987)). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Russell to display said licensable components for confirmation from a user prior to said license sales site generating said software site license. One of ordinary skill in the art would have been motivated to do this because it ensures that the user wants to purchase a particular license.

Note. Functional recitation(s) using the word "for" or other functional language (have been considered but are given little patentable weight because they fail to add any structural limitations and are thereby regarded as intended use language. A recitation of the intended use of

the claimed product must result in a structural difference between the claimed product and the prior art in order to patentably distinguish the claimed product from the prior art. If the prior art structure is capable of performing the intended use, then it reads on the claimed limitation. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) (“The manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself.”); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). See also MPEP §§ 2114 and 2115. Unless expressly noted otherwise by the Examiner, the claim interpretation principles in this paragraph apply to all examined claims currently pending.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 571-272-6714. The examiner can normally be reached on Monday - Friday 10:00 - 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt II can be reached on 571-272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jalatee Worjloh/
Primary Examiner, Art Unit 3685